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LSI LOGIC CORPORATION
Office of General Counsel
1621 Barber Lane
M/S D-106
Milpitas, CA 95035
Fax: (408) 433-7460

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To Name: USPTO – Box: Amendment
Fax: (703) 872-9306
Phone: (703) 305-8283

From: Name: Manu Kashyap, Intellectual Property Paralegal
Corporate Legal Dept.
Telephone: (408) 433-7475
Fax: (408) 433-7460

Re: 09/991,202

Number of Pages Including this Page 4

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MESSAGE:

US Serial No.: 09/991,202
Filing Date: November 21, 2001
Group Art Unit: 2812
Docket No: 01-555
Examiner: Stanetta D. Isaac
Response to Restriction Requirement

Please notify us immediately if any pages are not received.


PTO/SB/21 (02-04)

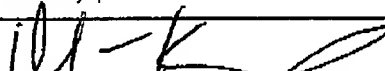
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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/991.202	
	Filing Date	November 21, 2001	
	First Named Inventor	Venkatesh P. Gopinath, et al.	
	Art Unit	2812	
	Examiner Name	Stanetta D. Isaac	
Total Number of Pages in This Submission	3	Attorney Docket Number	01-555

ENCLOSURES (Check all that apply)		
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Remarks Response to Restriction Requirement		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual name	Timothy R. Croll 36,771 (408) 433-7625	
Signature		
Date	September 14, 2004	

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Venkatesh P.)
Gopinath, et al.) Group Art Unit: 2812
)
) Examiner: Stanetta D. Isaac
Serial No.: 09/991,202)
) Atty. Docket No.: 01-555
Filed: November 21, 2001)
)
For: Shallow Trench Isolation Structure)
With Low Trench Parasitic Capacitance)
)

RESPONSE TO OFFICIAL ACTION
Restriction/Election Requirement

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This response is presented to the Office Action mailed August 25, 2004, wherein the Examiner required restriction pursuant to 35 U.S.C. §121. Election is hereby made, *with traverse*, to prosecute Group I, method claims 1-26.

Remarks/Arguments

Reconsideration of the restriction is respectfully requested. Restriction is not required by 35 U.S.C. §121, as suggested in the Office Action. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. §121 "... the Commissioner *may* require the application to be restricted...." (emphasis added).

Furthermore, MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct as claimed; and
- 2) There must be a serious burden on the examiner if restriction is required.

In searching the Group I claims, the class and subclass for the Group II claims will undoubtedly be searched, to ensure that no relevant art is overlooked. For this reason there is no significant burden on the examiner, and certainly no serious burden as required by MPEP §121.

In fact, maintaining the requirement for restriction not only burdens applicants with the additional costs associated with filing and prosecuting separate patent

applications, but also requires the examiner to duplicate efforts by examining multiple applications of closely related inventions. Such practice not only wastes public and private funds and Patent Office resources, but also leads to the possibility of inconsistent examinations of closely related inventions. Accordingly, applicants respectfully request that the examiner reconsider and withdraw the restriction requirement.

In light of the foregoing, applicants respectfully submit that a full and complete response to the Office Action is provided herein, and request that the application proceed to examination.

In the event this response is not timely filed, applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to deposit account 12-2252.

Respectfully Submitted,



Timothy R. Croll
Reg. No. 36,771
(408) 433-7625
LSI LOGIC CORPORATION
1621 Barber Lane
M/S D-106
Milpitas, CA 95035-7451

Date: September 13, 2004